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| 10/685,678 | 10/15/2003 | Walter Aichholzer | 510.1088 | 7076 |

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| EXAMINER | |
|---|---|
| TUROCY, DAVID P | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1762 | |

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 10/685,678 | AICHHOLZER ET AL. |
| | Examiner | Art Unit |
| | David Turocy | 1762 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *11/15/2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's arguments and amendments filed 11/15/2004 have been fully considered and reviewed by the examiner, but they are not persuasive. The examiner acknowledges the amendment of claim 7 and the specification. In light of the amendments the 35 USC 112 rejection of Claim 7 are withdrawn. Claims 1-9 are pending.

### *Response to Arguments*

2. Applicant's arguments filed 11/15/2004 have been fully considered but they are not persuasive.

3. The applicant has argued against the McCoy reference, arguing that they do not teach the claimed relative thicknesses between the two coats, where the first layer is 3 to 5 times larger then the second layer. The applicant has also argued that the McCoy reference shows the two coats having a similar thickness or showing the second coat larger then the first coat with no suggestion of a thinner second coat. The examiner agrees that McCoy et al does not discuss the relative thicknesses between the two coats, however, the examiner maintains that it is theoretically possible to select a thickness for each coat, within the ranges of McCoy, and achieve the claimed ratio of thicknesses.

4. The examiner acknowledges that the applicant has asserted criticality to the claimed relative thicknesses, however, the showing of criticality of first layer being 3 to 5 times larger then a second layer is unsubstantiated by a showing of fact. McCoy is not limited to any specific ratio between layer thicknesses and would thus encompass all permutations of relative thicknesses. The examiner recognizes that McCoy shows, through drawings, relatively equal coating thicknesses for the two coats and a thicker second coat. However, it is the examiners position that these showings are only a pair of embodiments of the invention, and the disclosure is not limited to such embodiments. Applicant argues that this ratio allows a comparable finish to conventional automotive finishes. It is noted that applicant's claims are broad enough to include ceramic materials. If applicant were to establish the criticality of their more narrow range within the broad parameters encompassed by the prior art and presented a claim commensurate in scope with such a showing, such a claim would distinguish over the art of record.

5. The applicant has argued against the Ellison reference, arguing that they suggest the relative thicknesses of the layers as being opposite as recited in the claims, where the first layer is less than that of the second layer. Ellison is merely applied by the examiner to show a method of producing a multi-layered film by applying a second layer by atomization and thus it would have been an obvious method of producing a multi layered film in McCoy for one of ordinary skill in that art, with the expectation of providing the desired film thickness.

***Specification***

1. The disclosure is objected to because of the following informalities: Paragraph 0001 claimed priority to German Patent Application No. DE 102 48 270.5-43 filed on October 16, 2003. Now after amendment claims priority to German Patent Application No. DE 102 48 270.5-43 filed on October 16, 2004, however, the German Patent Application No. DE 102 48 270.5-43 was actually filed on October 16 2002.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1,2,4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al (U.S. Application No 10034106) in view of the teachings of Ellison et al (U.S. Patent No. 4810540).

4. With respect to claim 1, McCoy et al ('106) reference teaches of a multi-layered decorative film with a first and second layer thicknesses of 0.3-3 mils (.75 – 75 microns), see paragraph 31 and 32, and that the first layer is applied using a slot/dye coater. This type of coater would fall within the broad group of a knife coater because the downstream edge of the slot coater functions as a knife. McCoy et al ('106) fails to

teach the relative thickness of the first layer being a factor of 3 to 5 times greater then that of the second layer.

Though the thicknesses are not disclosed as having the exact relationship claimed by applicant, the reference discloses a range that includes the relationship as claimed. The reference teaches of a range of .75 – 75 microns for either layer. The first layer can be 30 microns thick and the subsequent second layer can be 10 to 6 microns thick, or 3 to 5 times thinner then that of the first layer. In the case where the claimed ranges "overlap or lie" inside ranges disclosed by prior art a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257 191 USPQ 90. See MPEP 2144.05. Therefore it would be prima facie obviousness to select any two thicknesses within the disclosed range of McCoy et al ('106), including the relative thicknesses claimed by applicant.

McCoy et al ('106) also fails to teach the application of a second layer by atomization.

Ellison et al ('540) discloses a method of making a multi-layered decorative film. It is noted that McCoy et al ('106) incorporates by reference Ellison et al (U.S. Patent No 4810540) in the body of the specification. Ellison et al ('540) discloses a process of applying the first coat by rolling and a second coat by spraying. It is noted that while McCoy et al ('106) discloses the use of a slot/dye coater, they also disclose that the application "could utilize other conventional coaters"(paragraph 19). It is the examiners position that it would have been obvious to one of ordinary skill in the art to have substituted the conventional spray coater of Ellison et al ('540) for the slot/dye coater of

McCoy et al ('106). The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07. It is also noted that the applicants claim roll coating. Ellison et al ('540) discloses the use of rolling for the application of the first layer. It is the examiners position that it would have been obvious to one of ordinary skill in the art to have substituted the conventional roll coater of Ellison et al ('540) for the slot/dye coater of McCoy et al ('106).

5. With respect to claim 2, Ellison et al ('540) page 2, lines 8-19 teach that a transparent outer layer provides a glossy "wet look" to a multi-layer film. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a transparent outer layer for the purpose of providing a film with a "wet look".

6. With respect to claim 4, McCoy et al ('106) teaches, "the coatings are applied wet-on-wet". See pg. 1, paragraph 6, line 3.

7. With respect to claim 6, claim 6 merely recites intended use. McCoy et al ('106) and Ellison et al ('540) both disclose multi-layered films of similar thickness and pliability to that claimed. Therefore the examiner maintains that the product disclosed by McCoy

et al ('106) in view of the teaching of Ellison et al ('540) is capable of being applied to a bodywork component of a motor vehicle.

8. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al ('106) in view of Ellison et al ('540) as applied above, and further in view of Boris et al (U.S. Patent Number 6680104).

McCoy et al ('106) in view of Ellison et al ('540) are discussed above, but the references do not explicitly state that the transparent outer layer is formed by UV-curing varnish.

Boris et al ('104) discloses a multi-layer decorative film, similar to that disclosed by McCoy et al ('106). Boris et al ('104) teaches of an UV-curable protective lacquer system in the application of an outer protective layer. The examiner maintains that the outer layer of Boris et al ('104) provides the same function as that provided by the outer layer of Ellison et al ('540). Since both Ellison et al ('540) and Boris et al ('104) both disclose a transparent layer on flexible decorative films, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize UV-curable varnish to form the outer transparent layer. The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

9. Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al ('106) in view of Ellison et al ('540) as applied to claim 1 above, and further in view of Kiriazis et al (U.S. Patent No. 6132864).

10. With respect to claim 5, McCoy et al ('106) in view of Ellison et al ('540) fails to teach the drying the first layer before the application of the second layer.

Kiriazis et al ('864) discloses, in paragraph 28, the curing of the first layer can be carried out before overcoating with the second coat, or it is possible to overcoat the an uncured first coat with the second coat and then cure both layers together. Thus Kiriazis et al ('864) discloses that either wet-on-wet or wet-on-dry can be used for the application of plural coats on a film. Therefore, since McCoy et al ('106) teaches wet-on-wet application and Kiriazis et al ('864), making a similar film, discloses the use of either wet-on-wet or wet-on-dry, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute wet-on-dry method in place of a wet-on-wet method with the expectation of similar results.

11. With respect to claim 7, McCoy et al ('106) in view of Ellison et al ('540) fails to teach of a support thickness from 100 to 1200 microns.

Kiriazis et al ('864) discloses a multi-layered film, similar to that disclosed by Ellison et al ('540). Kiriazis et al ('864) teaches of a support material having a thickness of from 10 to 500 microns, page 1, column 1, lines 41-43. However, [a] prior art reference that discloses a range encompassing a somewhat narrower claimed range is

sufficient to establish a *prima facie* case of obviousness. *In re Peterson*. See MPEP 2144.05. Since Ellison et al ('540), McCoy et al ('106), and Kiriazis et al ('864) all teach of similar multi-layer films, of similar thicknesses and the capability of application to a component, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a support material having a thickness from 100 to 1200 microns.

12. With respect to claim 8, McCoy et al ('106) in view of Ellison et al ('540) fails to teach a component including a polymer material and a support thickness from 700 to 1200 microns.

In claim 8, " the component including a polymer material", merely recites intended use. McCoy and Ellison both disclose multi-layered films of similar thickness and pliability to that claimed by applicants. Therefore the examiner maintains that the product disclosed by McCoy et al ('106) in view of the teaching of Ellison et al ('540) is capable of being applied to a polymer material.

McCoy et al ('106) in view of Ellison et al ('540) also fails to teach a support thickness from 700 to 1200 microns.

Kiriazis et al ('864) discloses a multi-layered film, similar to that disclosed by Ellison et al ('540). Kiriazis et al ('864) teaches of a support material having a thickness of from 10 to 500 microns. See Kiriazis et al ('864) page 1, column 1, lines 41-43. A *prima facie* case of obviousness exists where the claimed ranges and prior art do not overlap but are close enough that one in ordinary skill in the art would have expected

them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 f.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05. It is the examiners position that a film thickness of 700 microns provides the similar properties of that of 500 microns. Since Ellison et al ('540), McCoy et al ('106), and Kiriazis et al ('864) all teach of similar multi-layer films, of similar thicknesses and the capability of application to a component, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize thicknesses, close to the referenced range, that have the same properties.

13. With respect to claim 9, McCoy et al ('106) in view of Ellison et al ('540) fails to teach a component including a metal.

In claim 8, " the component including a metal", merely recites intended use. McCoy et al ('106) and Ellison et al ('540) both disclose multi-layered films of similar thickness and pliability to that claimed by applicant. Therefore the examiner maintains that the product disclosed by McCoy et al ('106) in view of the teaching of Ellison et al ('540) is capable of being applied to a metal.

McCoy et al ('106) in view of Ellison et al ('540) also fails to teach a support thickness from 50 to 300 microns.

Kiriazis et al ('864) discloses a multi-layered film, similar to that disclosed by Ellison et al ('540). Kiriazis et al ('864) teaches of a support material having a thickness of from 10 to 500 microns. See Kiriazis et al ('864) page 1, column 1, lines 41-43. In the case where the claimed ranges "overlap or lie" inside ranges disclosed by prior art a

*prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257 191 USPQ 90. See MPEP 2144.05. The examiner maintains that a thickness of 200 microns lies within the specific range of both Kiriazis et al ('864) and the claimed range. Since both Ellison et al ('540, McCoy et al ('106), and Kiriazis et al ('864) all teach of similar multi-layer films, it would be obvious to one of ordinary skill in the art at the time the invention was made to utilize a support material within the claimed range.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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